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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,411	10/12/2001	Amy B. Reed	03768/09633	1102
22827	7590	02/24/2005	EXAMINER	
DORITY & MANNING, P.A. POST OFFICE BOX 1449 GREENVILLE, SC 29602-1449			VO. HAI	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/976,411

Applicant(s)

REED ET AL.

Examiner

Hai Vo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. The 112 claim rejections are withdrawn in view of the present arguments (see page 6 of the amendment filed on 12/17/2004).
2. The art rejections over Brown Reed et al (US 6,156,677), Bouchette (US 4,692,374) and Weber et al (US 5,191,734) are maintained.
3. The double patenting rejections are maintained until the submission of a terminal disclaimer.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 21-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,743,522 substantially set forth in the 09/16/2004 Office Action. The double patenting rejections are maintained until the submission of the terminal disclaimer.

### ***Claim Rejections - 35 USC § 102***

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 21-31 and 36-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown Reed et al (US 6,156,677) substantially set forth in the 09/16/2004 Office Action. The examiner wishes to confirm claims 30, 31, 39 and 40 should be included in the 102 art rejections above. Brown Reed discloses the saturant including a blend of poly(vinylidene chloride)-acrylonitrile-butyl acrylate and a carnauba wax emulsion which reads on Applicants' additional polymer emulsion. The art rejections have been maintained for the following reasons. Applicants argue that Brown Reed discloses the saturant including poly(vinylidene chloride)-acrylonitrile-butyl acrylate copolymer, a mixture of such polymer with a carnauba wax emulsion, or a mixture of a poly(vinylidene chloride)-acrylate copolymer and a carnauba wad emulsion (column 2, lines 33-51). Applicants assert "as correctly noted by the examiner Brown Reed fails to disclose the use of a polymer emulsion having a glass transition temperature of  $-20^{\circ}\text{C}$  or less." The examiner disagrees. The examiner has never asserted it

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because if she did, the basis for the inherency could not be established and the 102 art rejections over Brown Reed with respect to claims 21-31 and 36-40 were flaw and improper. Based on reference disclosure at column 2, lines 33-51, the examiner agrees that Brown Reed does not teach a medical packaging substrate wherein the saturant comprises ***an additional polymer emulsion*** having a glass transition temperature of -20°C or less because it is recognized that a carnauba wax emulsion does not have a glass transition temperature but a melting temperature of 80 °C. Applicants have provided evidence showing that the product of Brown Reed does not necessarily possess the claimed percent bacterial filtration efficiency (%BFE) of at least about 95%. However, the declarations are not found persuasive to overcome the rejections because they are not commensurate in scope with the claims. Dr. Jay R. Sommers in the 02/23/2004 Affidavit established that the medical packaging substrate of the present invention has improved %BFE over the substrate of the Brown Reed invention. Karen Bean in the 07/02/2003 affidavit conducted an experiment to demonstrate the sample of the medical packaging disclosed in Brown Reed '677 having an average %BFE of 92.45%. Applicants then conclude that the affidavits establish overwhelming evidence that Applicants' claimed %BFE range is not inherent to the disclosure of Brown Reed. Both Affidavits are completely silent as to why the product of Brown Reed fails to meet the %BFE as presently claimed. It is recognized that the two products made of the same materials could have different physical properties if the processes from which they are made are

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different. The medical packaging of the Brown Reed invention and the present application are made from exactly the same process, therefore the question is raised what causes the differences in the %BFE of the two products. It is true that products of identical chemical composition can not have mutually exclusive properties. Hence, differences in the compositions from which the substrates are made lead to differences in the %BFE. The examiner suggests that limitations of either claim 32 or claim 41 must be incorporated in independent claims to commensurate in scope with the affidavits, thereby overcoming the art rejections.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 21-41 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bouchette (US 4,692,374) substantially as set forth in the 09/16/2004 Office Action. The art rejections have been maintained for the following reasons. Applicants argue that Bouchette completely silent as to a medical packaging substrate according to the present claims. The recitation "a medical packaging substrate" has not given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not

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depending for completeness upon the introductory clause. ***Kropa v. Robie***, 88 USPQ 478 (CCPA 1951). Applicants further argue that Bouchette completely fails to disclose or suggest the use of a polymer emulsion having a glass transition temperature of -20°C or less. The examiner disagrees. In addition to Airflex A-410 and Airflex A-106 binders (ethylene vinyl acetate emulsions) and HA-8 binder (ethylene acetate emulsions) having a glass transition temperature of 4°C, 0°C and -10°C respectively, outside the claimed range, Bouchette also discloses the use of acrylate emulsions, butadiene-styrene emulsions and acrylonitrile-butadiene emulsions which are exactly the same binders being employed by Applicants. Accordingly, Bouchette discloses the use of a polymer emulsion having a glass transition temperature of -20°C or less. This is in line with ***In re Spada***, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. Accordingly, the examiner respectfully submits that the claimed %BFE would necessarily flow from the teachings of the applied reference.

10. Claims 21-41 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Weber et al (US 5,191,734) substantially as set forth in the 09/16/2004 Office Action. The art rejections have been maintained for the following reasons. Applicants argue that Weber completely silent as to a medical packaging substrate according to the present claims. The recitation "a medical packaging substrate" has not given patentable weight because it has been held that a preamble is denied the effect of a



limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. ***Kropa v. Robie***, 88 USPQ 478 (CCPA 1951). Applicants further argue that there is no suggestion the claimed %BFE range would necessarily be possessed by the biodegradable latex web materials of Weber in view of the affidavits which demonstrate that actual packaging substrate material like those of Brown Reed have been tested and have exhibited significantly reduced %BFE values outside the claimed range. The arguments are not found persuasive for patentability. The affidavits demonstrate the medical packaging substrate of Brown Reed does not have the %BFE within the claimed range. The affidavits do not establish that the BFE% not be necessarily present in the biodegradable latex web materials of Weber. Further, the biodegradable latex web material of Weber comprises a fibrous web being saturated with a latex binder. The binder is a blend of polyacrylate and styrene-butadiene polymer, which are exactly the same materials being used by Applicants. The latex binder is about 16 to 80 dry parts per 100 parts fibers by weight (column 5, line 29) within the claimed range. Since Weber uses the same materials to form the saturant as Applicants, it is the examiner's position that the glass transition temperatures of the binders would be inherently present. Like material has like property. This is in line with ***In re Spada***, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. Accordingly, the examiner respectfully submits that



the claimed %BFE would necessarily flow from the teachings of the applied reference.

***Conclusion***

**11. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**12.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HV

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